



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,994	08/09/2000	Howard Dernehl	DERN-00101	5407
28960	7590	09/17/2004	EXAMINER	
HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086				YOUNG, JOHN L
ART UNIT		PAPER NUMBER		
		3622		

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/635,994	DERNEHL ET AL. <i>(S)</i>	
Examiner	Art Unit		
John L Young	3622		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 03 June 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-49 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-49 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

**JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER**

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/16/2004.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

**NON-FINAL REJECTION****DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

**CLAIM REJECTION – 35 U.S.C. §103( a )**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-49 are rejected under 35 U.S.C. §103(a) as being unpatentable over Perri, III US 2001/0020231 (Sep. 6, 2001) [US f/d: Apr. 24, 2000] (herein referred to as “Perri”).

As per claim 1, Perri (the ABSTRACT; FIG. 12; FIG. 11; FIG. 2; FIG. 5; FIG. 7; FIG. 10; FIG. 13; FIG. 14B; FIG. 14A; FIG. 14C; FIG. 14E; FIG. 14F; FIG. 17A; ¶¶[0010]; [0014]; [0015]; [0016]; [0053]; [0055]; [0068]; [0069]; [0072]; [0076]; [0077]; and [0078] and whole document) implicitly shows: “A

Art Unit: 3622

method of marketing a marketable entity selected from a group consisting of goods and services, the method comprising the steps of . . . creating a digital data base controlled by a Provider . . . offering a potential reward to a first party in exchange for promotional assistance of the first party, the promotional assistance comprising assistance in a forwarding of a first e-mail message to a second party, the first e-mail message comprising a personalized referral for the marketable entity, and a first set of data comprising a first serial number and a first URL link . . . creating a first Web site corresponding to the first URL link, the first Web site providing information on the referenced marketable entity and an offer to transact for the referenced marketable entity . . . correlating the first set of data in the first e-mail message to a first set of database data within the database, including data within the database relating to the potential reward offered to the first party in exchange for promotional assistance; and . . . forwarding the first e-mail message to a second party.”

Perri lacks explicit recitation of “a first serial number. . .”, however, it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Perri (¶ [0069]) “sponsor identifier. . .” implicitly shows “a first serial number. . .”; and it would have been obvious to modify and interpret the disclosure of Perri cited above as showing “a first serial number. . .”, because modification and interpretation of the cited disclosure of Perri would have “[enticed] people to recommend a

Art Unit: 3622

*participating merchant. . . .*" in various marketing campaigns, based on the motivation to modify Perri so as to "present [a] marketing system . . . that . . . eliminates the need for traditional advertising that requires expenditure of money prior to sales. . . ."

(see Perri (¶ [0019])).

As per dependent claims 2-45, Perri shows the method of claim 1 and subsequent base claims depending from claim 1.

Perri (the ABSTRACT; FIG. 12; FIG. 11; FIG. 2; FIG. 5; FIG. 7; FIG. 10; FIG. 13; FIG. 14B; FIG. 14A; FIG. 14C; FIG. 14E; FIG. 14F; FIG. 17A; ¶¶[0010]; [0014]; [0015]; [0016]; [0053]; [0055]; [0068]; [0069]; [0072]; [0076]; [0077]; and [0078] and whole document) implicitly shows all of the elements and limitations of claims 2-45; however,

Perri lacks explicit recitation of some of elements and limitations of claims 2-45; therefore,

Official Notice is taken that both the concepts and the advantages of those elements and limitations of dependent claims 2-45 not explicitly shown by Perri were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Perri cited above combined with the knowledge of one skilled in the art implicitly shows those elements and limitations of claims 2-45 which are not explicitly recited in Perri; and it would

Art Unit: 3622

have been obvious to modify and interpret the disclosure of Perri cited above as implicitly showing all of the elements and limitations of claims 2-45, because modification and interpretation of the cited disclosure of Perri would have “[enticed] people to recommend a participating merchant. . . .” in various marketing campaigns, based on the motivation to modify Perri so as to “*present [a] marketing system . . . that . . . eliminates the need for traditional advertising that requires expenditure of money prior to sales. . . .*” (see Perri (¶ [0019])).

Independent claim 46 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 47-49, Perri shows the method of claim 46 and subsequent base claims depending from claim 46.

Perri (the ABSTRACT; FIG. 12; FIG. 11; FIG. 2; FIG. 5; FIG. 7; FIG. 10; FIG. 13; FIG. 14B; FIG. 14A; FIG. 14C; FIG. 14E; FIG. 14F; FIG. 17A; ¶¶[0010]; [0014]; [0015]; [0016]; [0053]; [0055]; [0068]; [0069]; [0072]; [0076]; [0077]; and [0078] and whole document) implicitly shows all of the elements and limitations of claims 47-49; however,

Perri lacks explicit recitation of some of elements and limitations of claims 47-49; therefore,

Art Unit: 3622

Official Notice is taken that both the concepts and the advantages of those elements and limitations of dependent claims 47-49 not explicitly shown by Perri were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Perri cited above combined with the knowledge of one skilled in the art implicitly shows those elements and limitations of claims 47-49 which are not explicitly recited in Perri; and it would have been obvious to modify and interpret the disclosure of Perri cited above as implicitly showing all of the elements and limitations of claims 47-49, because modification and interpretation of the cited disclosure of Perri would have “[enticed] people to recommend a participating merchant. . . .” in various marketing campaigns, based on the motivation to modify Perri so as to “present [a] marketing system . . . that . . . eliminates the need for traditional advertising that requires expenditure of money prior to sales. . . .” (see Perri (¶ [0019])).

## **EXAMINER'S RESPONSE TO ARGUMENTS**

3. Applicant's arguments (Amendment paper filed 06/03/2004) have been fully considered but they are not persuasive for the following reasons:

Applicant's arguments are moot because new grounds of rejection introduced herein by the Examiner.

Art Unit: 3622

## **CONCLUSION**

4. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist

Crystal Park V

2451 Crystal Drive

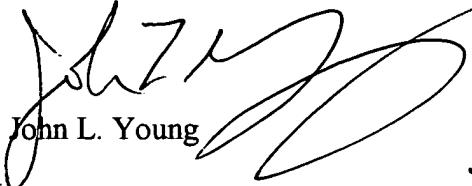
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young  
Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

September 16, 2004

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER